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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/635,027    08/04/00    BANERJEE

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EXAMINER
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HM12/0418

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WHISENANT, E	
ART UNIT	PAPER NUMBER

1655  
DATE MAILED:

*3*

04/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
09/635,027

Applicant(s)  
Banerjee R.

Examiner  
Ethan Whisenant, Ph.D. (FSA)

Group Art Unit  
1655



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1 \_\_\_\_\_ is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1 \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

## DETAILED ACTION

### SEQUENCE RULES

**1.** This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

### CLAIM OBJECTIONS

**2.** Claim(s) 1 is /are is objected to for the following minor informalities. The numbering of claims is not in accordance with 37 CFR 1.126. The claim lacked a number. It has now been numbered as Claim 1. Please note the following comments which are derived from the MEP. and related to the preferred form of the claims.

#### MEP. 608.01(m) [R-1] Form of Claims

The claim(s) must commence on a separate sheet and should appear after the detailed description of the invention. While there is no set statutory form for claims, the present Office practice is to insist that each claim must be the object of a sentence starting with "I (or we) claim", "The invention claimed is" (or the equivalent). If, at the time of allowance, the quoted terminology is not present, it is inserted by the clerk. Each claim begins with a capital letter and ends with a period. Periods may not be used elsewhere in the claims except for abbreviations. See *Fressola v. Manbeck*, 36 USPQ2d 1211 (D.D.C. 1995). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation, 37 CFR 1.75(I).

There may be plural indentations to further segregate subcombinations or related steps. In general, the printed patent copies will follow the format used but printing difficulties or expense may prevent the duplication of unduly complex claim formats. Reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. The reference characters, however, should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear

in the claims. The use of reference characters is to be considered as having no effect on the scope of the claims.

Many of the difficulties encountered in the prosecution of patent applications after final rejection may be alleviated if each applicant includes, at the time of filing or no later than the first reply, claims varying from the broadest to which he or she believes he or she is entitled to the most detailed that he or she is willing to accept.

Claims should preferably be arranged in order of scope so that the first claim presented is the least restrictive. All dependent claims should be grouped together with the claim or claims to which they refer to the extent practicable.

#### 35 U.S.C. § 112- 2ND PARAGRAPH

**3.** The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

#### CLAIM REJECTIONS under 35 U.S.C. § 112- 2ND PARAGRAPH

**4.** Claim(s) 1 is/are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**Claim 1** is indefinite because there is no nexus between the preamble and the claim steps. Claim 1 in its preamble direct to a method which is to accomplish a particular goal. However, none of the claim steps states that this goal is accomplished. For clarity, claimed methods should recite that the purpose of the method has been attained (i.e. provide a nexus between the preamble and the claim steps).

**Claim 1** is indefinite because the phrase "the treated patients" on line 5 lacks proper antecedent basis.

**Claim 1** is indefinite because the phrase "removing the PBS processing the cell pellets following according to ..." on lines 11-12 is nonsequitur.

**Claim 1** is indefinite because the steps 6 and 11 are conflicting. Are steps 7-10 part of the protein and DNA isolation steps? The phrase "the protein and DNA isolation steps comprising" in step 6 is

confusing in light of step 11 which recites "Performing simultaneous isolation of protein and DNA comprising the steps of ".

**Claim 1** is indefinite because it is unclear what is intended by step 62.

Finally, **Claim 1** is indefinite because it is unclear what is intended by the phrases: " 100 l "; " 200 l/ml " and " ten l " in steps 30, 33, and 47.

#### EXAMINER COMMENT

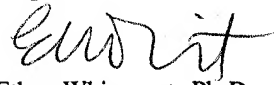
**5.** **Claim(s) 1**, as drawn, is very narrow in scope and appears to be allowable as a result. I was unable to obtain a copy of the Caruccio dissertation. If you have a copy, its inclusion into the record via a PTO-1449 would be greatly appreciated. All references that have been considered as prior art are shown on the attached PTO-942.

#### CONCLUSION

**6.** **Claim(s) 1** is/are rejected and/or objected to for the reason(s) set forth above.

**7.** Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ethan Whisenant, PhD. whose telephone number is (703) 308-6567. The examiner can normally be reached Monday-Friday from 8:30AM -5:30PM EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached at (703) 308-1152.

The fax number for this Art Unit is (703) 308-8724. Before faxing any papers please inform the examiner to avoid lost papers. Please note that the faxing of papers must conform with the Notice to Comply published in the Official Gazette, 1096 OG 30 (November 15, 1989). Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-0196.

  
Ethan Whisenant, Ph.D.  
Primary Examiner (FSA)